

REMARKS

Claims 1-50 are pending in this application. Claim 50 is added by this paper. As originally written claims 1, 3, 5-12, 28, 32-34, and 36 did not invoke 35 U.S.C. §112, ¶6 as the claims do not recite the phrase “step for” and do recite acts. In the present amendment, claims 1, 3, 5-12, 28, 32-34, and 36 have been amended to explicitly recite “the acts of” or “the act of” to make even more clear that none of the limitations in any of these claims invoke 35 U.S.C. §112, ¶6. Rather, where a limitation falls within 35 U.S.C. §112, ¶6, to aid in the public notice function of the claims, Applicants have explicitly recited either the phrase “means for ...” or “step for ...” for those limitations invoking 35 U.S.C. §112, ¶6.” Similarly, to aid in the public notice function of the claims, limitations which do not explicitly recite the phrase “means for” or “step for” do not invoke 35 U.S.C. §112, ¶6.

Claim Rejections - 35 U.S.C. § 112

Claim 5 was rejected under 35 U.S.C. § 112, ¶2 for lacking an antecedent basis for the limitation of “the step of scanning.” Claim 5 has been amended to rectify this concern. Additionally, claim 5 has been amended to remove the word “step” to aid in the public notice function that the neither dependent claim 5, nor independent claim 1, invokes 35 U.S.C. § 112, ¶6.

Claims 19-21, 22-24, 31, 41, and 45-47 were rejected under 35 U.S.C. § 112, ¶2. Applicants respectfully traverse these rejections. When evaluating a claim for compliance with 35 U.S.C. § 112, ¶2, the Examiner “must consider the claim as a whole to determine whether the claim appraises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph.” MPEP § 2173.02. Claims 19-24, 31, 41, and 45-47 clearly appraise one skilled in the art of their scope, thus satisfying 35 U.S.C. §112, ¶2. Claims 22-24 have been amended to clarify that the “transport mechanism is adapted to transport the documents along the transport path” at the recited rates. However, applicant believes that the rejected dependent claims “distinctly point out and distinctly claim” what Applicant regards as his invention. The limitations of claims 22-24 point out the rate of operation of the transport mechanism.

Claims 19-21 and 45-47 point out the number of “output receptacle[s] adapted to receive a predetermined number of documents after they have been processed.” Dependent claims 19-21 and 45-47 limit the number of output receptacles contained on the device for processing documents

recited in claims 13 and 37, respectively. These limitations in the dependent claims narrow the scope of the dependent claims relative to the independent claims from which they depend. Thus, Applicant respectfully believes that claims 19-21 and 45-47 particularly point out and distinctly claim what Applicant regards as his invention.

Dependent claim 31 recites that the “predetermined limit is 2000 documents” for the number of documents that may be received by the at least one output receptacle of independent claim 28. Thus, claim 31 limits the number of documents that may be found in the “at least one output receptacle” to 2000 documents. Applicant respectfully believes that claim 31 satisfies 35 U.S.C. § 112 ¶2.

Dependent claim 41 adds an additional limitation to the device of claim 37, adding “a printer coupled to said controller” of claim 37. Thus the device of claim 41 clearly requires a printer in addition to the limitations of claim 37.

Claim Rejections - 35 U.S.C. § 102

Claims 1-49 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,022,531 issued to Horino et al (“Horino”). Horino teaches a bundle processing apparatus with pack counting capabilities. Horino in no way discloses a device, or a method, for processing substitute currency media. Additionally, several limitations of the pending claims are neither taught nor suggested by Horino.

Independent claim 1 of the pending application recites “transporting each of the documents, one at a time, past a detector” and “detecting the document-identifier of each substitute currency medium.” “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987); MPEP § 2131. Horino discloses a bundle processing device that receives a bundle of currency bills comprising a number of packs. Each of the packs contains a number of currency bills. Col. 2, ll. 56-60; Col. 3, ll. 8-15. Horino teaches that an entire bundle of documents is moved through the device at one time. Col. 3, ll. 16-21. The Horino device has a pack counting section to “count the number of packs t, which are sealed by small bands, constituting the bundle T.” Col. 3, ll. 30-35. Horino further discloses a “denomination detection section” that takes “[a]n image of the bundle T” using “a scanning camera 232 as shown

in FIG. 6.” Col. 3, ll. 61-66. FIGS. 5 and 6 of Horino also clearly depict an intact bundle T being evaluated, not individual documents. Additionally, throughout the Horino disclosure, the bundle T is being evaluated, not individual documents that make up the bundle. *See*, Col. 3, ll. 40-44; Col. 3, l. 60 – Col. 4, l. 2; Col. 7, ll. 10-26. Horino, thus discloses a device that transports a bundle of bills T wrapped in a band J through the device. *See*, FIGS. 1, 5, and 8. For at least these reasons Horino does not disclose “transporting each of the documents, one at a time, past a detector” and “detecting the document-identifier of each substitute currency medium.” Thus, Horino fails to teach or disclose all of the limitations of claim 1, and does not anticipate claim 1.

Independent claim 13 of the present application recites “a transport mechanism adapted to transport the documents, one at a time, from the input receptacle to the at least one output receptacle along a transport path” and “an evaluation unit comprising at least one detector disposed along the transport path between the input receptacle and the output receptacle, the at least one detector being capable of detecting the document-identifier for each document.” As previously discussed with respect to independent claim 1, Horino discloses transporting bundles of documents, not transporting individual documents “one at a time.” As Horino transports bundles, Horino does not disclose “detecting the document-identifier for each document” as required by claim 13. Therefore, Horino fails to teach or disclose all of the limitations of claim 13, and fails to anticipate claim 13.

Independent claim 28 of the present application recites several limitations, among them “transporting each of the documents, one document at a time, past a detector in said document processing device” and “detecting the document-identifier for each substitute currency medium.” As previously described, Horino does not teach or suggest either of these limitations, but rather transports entire bundles and detects a single document of a bundle. Consequently, Horino fails to teach or disclose at least these limitations of claim 28, and fails to anticipate claim 28.

Independent claim 37 recites “a transport mechanism adapted to transport the documents, one at a time, from the input receptacle to the at least one output receptacle along a transport path” and “an evaluation unit including at least one detector disposed along the transport path between the input receptacle and the at least one output receptacle, the at least one detector being capable of evaluating documents and detecting the document-identifier for each substitute currency medium.” As mentioned previously, Horino only discloses transporting and evaluating wrapped bundles of

documents. Hence, Horino fails to teach or disclose all of the limitations of claim 37, and fails to anticipate claim 37.

Claims 2-12, 14-27, 29-36, and 38-49 are dependent claims that depend from at least one of the independent claims previously discussed. As none of the independent claims are anticipated by Horino for the reasons given above, none of the dependent claims are anticipated by Horino for at least those same reasons.

Conclusion

It is Applicants' belief that all of the claims are now in condition for allowance, and action towards that effect is respectfully requested. A check is enclosed in the amount of \$250 to cover the cost of the additional claim submitted in this paper. Should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47171-00413USPT.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

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Respectfully submitted,

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